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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,855	02/20/2004	Takasi Kumagai	P-8116	7643
28107	7590	11/20/2006	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			, HU, KANG	
			ART UNIT	PAPER NUMBER
			3709	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/783,855

**Applicant(s)**

KUMAGAI, TAKASI

**Examiner**

Kang Hu

**Art Unit**

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/20/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Preliminary amendment filed 7/18/03 has been entered.

#### *Specification*

2. The disclosure is objected to because of the following informalities:

Page 2, line 11: "which the played a game" should be -- which the player played a game --.

Page 2, line 13: "in this photographing" should be -- in this photograph --.

Page 5, line 11: "from an arrangement" is redundant and should be deleted.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the applicant did not provide any description of the "intensive control unit" in claim 12, lines 3-5.

Appropriate correction is required.

#### *Claim Objections*

4. Claims 11 and 13 are objected to because of the following informalities:

Claim 11, line 3: "compares a game with an immediately preceding game" should be -- compares a game result with an immediately preceding game result --.

Art Unit: 3709

Claim 13, line 3: "player as a subject gets a photograph" should be -- player as a subject gets his or her photograph taken --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Re claim 1, the applicant did not provide the essential components for the photographing system, the subject matter of the claimed invention.

Re claim 18, the applicant did not provide the essential processes for the method, the subject matter of the claimed photograph service.

Art Unit: 3709

Claims 2-17 and 19-24 are considered to be non-enabling because they are dependent upon claims 1 and 18.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1: the claim is ambiguous as to the meaning of “playing a game with the game machine in one frame together with the result of the game” in lines 3 and 4. The examiner is confused as how the game result can be in the same frame of photo while the player is still playing the game. The claim is also ambiguous as to the meaning of “result of the game desired by the player” in line 4 as the player can wish for many different outcomes to be displayed on a display apparatus.

Re claims 2, 4, 5, 9 - 11, 14, 20 and 22: the phrase “such as” and “and the like” throughout the claims renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “such as” and “and the like”), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). It is suggested that the applicant state exactly the conditions and devices that was described in the specifications.

Re claim 3, line 3; claim 4, line 3; claim 11, line 6 recites the limitation "outside". There is insufficient antecedent basis for this limitation in the claims. The phrase "outside" in the claims also renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "outside"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). It is suggested that the applicant state exactly the destination of the result of the game that was described in the specification.

Re claim 5: the subject matter "photoelectric conversion light-receiving connector" in line 6 and "positioning member" in line 8 of the claim can not be understood in light of the specification. The applicant needs to clearly state the function of these subject matters and how they are relevant to each other according to the specification.

Re claim 14: the claim recites the limitation "subject" in line 4. There is insufficient antecedent basis for this limitation in the claims.

Re claim 15: the claim is ambiguous as to the meaning of "image recording surface" in line 4. It is suggested that the applicant state exactly the device that was described in the specification.

Re claim 18, line 4 recites the limitation "the result of the game". There is insufficient antecedent basis for this limitation in the claim. The applicant did not specifically specify

Art Unit: 3709

which game result it is referring to. Lines 9 and 10 recites the limitation “the contents of the game”. There is insufficient antecedent basis for this limitation in the claim. The claim is also vague in regards to whether it is the result of the game or the content of the game that is being photographed with the player.

Re claim 19, lines 4 and 5 recites “calls the clerk in charge of change request means disposed to a game machine”; Re claim 21, lines 2 and 3 recites “the game machine comprises photographing request means”. Claims 19 and 21 conflict each other in its way for requesting a clerk. It is ambiguous as to the function of the change request means and the photographing request means.

Re claim 21, line 4 recites the limitation “the person”. There is insufficient antecedent basis for this limitation in the claim. The phrase “the person” also renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “the person”), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). It is suggested that the applicant states exactly the person that was described in the specification.

Claims 2-17 and 19-24 are also considered to be indefinite because they are dependent upon claims 1 and 18.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8-18, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (US 2002/0196342 A1).

Re claim 1: Walker discloses in his invention a photographing system for displaying a result of a game arranged to take a photograph of at least a player of a game machine (see page 2, paragraph 26) and the player playing a game with the game machine in one frame together with the result of the game (see page 2, paragraph 29), wherein a result of the game desired by the player is displayed on a display apparatus as well as a photograph is taken together with the display apparatus on which the result of the game is displayed or by directly transmitting the result of the game output from the display apparatus to a recording section of a photographing apparatus, and the result of the game is photographed in the same frame in which the player is contained (page 2, paragraph 23).

Re claim 2: Walker further discloses the game machine has a function for outputting the contents of a game to an external recording medium such as a magnetic card and the like, the display apparatus has a function for inputting the contents of the game recorded in the external recording



Art Unit: 3709

medium, and the display apparatus displays a result of a predetermined game of the game machine through the external recording medium (see page 6, paragraph 61; page 19, paragraph 185).

Re claim 3: Walker further discloses the game machine comprises a data output connector for outputting the result of the game to the outside, and the display apparatus comprises a data collection connector that is connected to the connector of the game machine and inputs the result of the game output from the game machine (page 6, paragraph 61).

Re claim 4: Walker further discloses the game machine has a function for outputting the result of the game to the outside by a radio system data transmission using visible light rays, infrared rays, electromagnetic waves, and the like, and the display apparatus has a transmitted data collecting/receiving function for inputting the result of the game output from the game machine (page 4, paragraph 66; page 16, paragraph 161).

Re claim 5: Walker further discloses the game machine comprises light-emitting means disposed near an external recording medium insertion slot for displaying a connecting state of the game machine to the external recording medium such as a magnetic card and the like, the display apparatus comprises a photoelectric conversion light-receiving connector for collecting data, the photoelectric conversion light-receiving connector comprises a positioning member acting as positioning means that is inserted into and engaged with the external recording medium insertion slot, a light emitter of the game machine is disposed in confrontation with a photoelectric

Art Unit: 3709

conversion light receiving section of the photoelectric conversion light-receiving connector by the positioning member, and the data of the result of the game of the game machine is output to the display apparatus by emitting predetermined protocol. The light-emitting means of the game machine by a predetermined protocol (page 6, paragraphs 61 and 62).

Re claim 6: Walker further discloses the display apparatus comprises a manual setting mechanism, and at least a part of the result of the game displayed by the game machine is manually input to the display apparatus or the contents of the result of the game displayed by the game machine are manipulated by the manual setting mechanism, respectively (page 9 and 10, paragraph 93).

Re claim 8: The claim invokes 35 U.S.C. 112 sixth paragraph and will be treated as such. Walker further discloses the game machine comprises means for calling a clerk in charge of photographing (page 2, paragraph 29; page 15, paragraph 153).

Re claim 9: The claim invokes 35 U.S.C. 112 sixth paragraph and will be treated as such. Walker further discloses the game machine displays that change request input means such as a change request button and the like also acts as means for requesting photographing (page 3, paragraph 30; page 10, paragraph 98)

Re claim 10: Walker further discloses the game machine outputs a result of an immediately preceding game to an external recording medium by an operation for outputting the data to an

Art Unit: 3709

external device such as insertion of the external recording medium, and the like into the game machine (page 6, paragraph 61; page 18, paragraph 174).

Re claim 11: Walker further discloses the game machine compares a game with an immediately preceding game, records a result of a game having high evaluation under a specific evaluating condition such as a high score, a high magnification, and the like and outputs a result of a game that has obtained a maximum evaluation in a series of games to the outside (page 4 and 5, paragraph 46 - 48).

Re claim 12: The claim invokes 35 U.S.C. 112 sixth paragraph and will be treated as such.

Walker further discloses the game machine automatically outputs the result of the game to an intensive control unit of a game hall as well as comprises means for requesting to feed back the result of the game automatically output to the intensive control unit to the game machine, and the data of the result of the game fed back through the game machine is output to the display apparatus (page 4 and 5, paragraph 44-49).

Re claim 13: Walker further discloses the display apparatus is of a hand-held type, and the player as a subject gets a photograph while holding the display apparatus showing the result of the game (page 5, paragraph 52).

Re claim 14: Walker further discloses the display apparatus is of a shoulder type and the like so that it can be directly fitted to the player as the subject (page 17, paragraph 169).

Re claim 15: Walker further discloses the display apparatus is built in the photographing apparatus, and the result of the game input to the display apparatus is displayed and recorded on an image recording surface in photographing (page 23, paragraph 228).

Re claim 16: Walker further discloses an instant camera, and a display on the light-emitting type data display surface of the display apparatus is printed to a film of the camera (page 19, paragraph 185).

Re claim 17: Walker further discloses the photographing apparatus comprises a digital camera having a CCD, and a display on the light-emitting type data display surface of the display apparatus is output to the CCD through a reduction lens (page 23, paragraph 228).

Re claim 18: Walker discloses a method of providing a service using a photographing system for displaying a result of a game arranged to take a photograph of at least a player of a game machine and the player playing a game with the game machine in one frame together with the result of the game, wherein a photographer is limited to a clerk in charge of photographing who is admitted to execute photographing in a game hall, at least one of a winning pattern, the amount of a prize, the amount of dropped money, a winning multiplication of the contents of a game is displayed on the game machine or an display apparatus, and the player gets a photograph in which the player and the game machine or the display apparatus, which displays the contents of the game, are photographed in one frame (page 2, paragraph 23; page 18, paragraph 174).

Art Unit: 3709

Re claim 22: Walker further discloses the game machine is arranged such that when a high evaluation is obtained under specific conditions of a high multiplication, a high score, and the like in which a predetermined multiplication, for example, is achieved with respect to an amount of dropped money as a result of a game, change request display means, photographing request display means, or photographing recommendation display means is automatically operated, and the clerk in charge of photographing is called by the display means (page 18, paragraph 174).

Re claim 24: Walker further discloses a photographing fee is previously set to photographing, and when the photographing is executed, the photographing fee is directly asked to a player or drawn from money on deposit (page 20, paragraph 192 and 193).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 19, 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (2002/0196342A1) in view of Walker et al. (2002/0128057A1). The teachings of Walker '342 have been discussed above.

Art Unit: 3709

Re claim 7: However Walker 342' did not disclose the photographing apparatus are mounted on a cart that is circulated by a clerk in charge in a hall in which game machines are installed.

Re claim 19: Walker 342' also did not disclose the clerk in charge of photographing is a clerk in charge of change whose job is to circulate in a game hall at all times and to change money, a player calls the clerk in charge of change through change request means disposed to a game machine and directly requests the clerk in charge of change to take a photograph or to change money.

Re claim 20: The claim invokes 35 U.S.C. 112 sixth paragraph and will be treated as such.

Walker 342' also did not disclose the game machine is provided only with change request means such as a change request lamp and the like, the player calls the clerk in charge of change using the change request means and orally requests the person to take a photograph or to change money, and it is displayed to the change request input means such as the change request button and the like that the means also acts as means for requesting photographing.

Re claim 21: Walker 342' further did not disclose the game machine comprises photographing request means, and the clerk in charge of change can confirm the request of a player before the person reaches the player who called him or her.

Re claim 23: Walker 342' further did not disclose a photographing apparatus is loaded on a cart that is used by the clerk in charge of change to transport money for change when the clerk

Art Unit: 3709

circulates, and the clerk in charge of change called by a player can change money or take a photograph at once in correspondence to the request of the player.

Walker 057' teaches the use of a change request button on the gaming device (page 14, paragraph 107) to request a change clerk to come and provide change to the player.

Therefore in view of Walker 057', it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the request for change lamp to request a change clerk to roll a cart equipped with change and other useful tools such as a camera over to provide change to the player and take a photo of the player as requested as it would be convenient because the change clerk would always be available to provide change to the players on the casino floor and he would always need a apparatus to help him carry the change.

Walker 342' and Walker 057' are analogous art because they are from the same field of endeavor of entertainment system.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP757' teaches the use of photographed image along with the game machine in a printed format. Walker 636' teaches of a method of generating outcome from a printed book of various slot machine outcomes. Walker 016' teaches the use of security camera and other portable devices for documenting player's reaction to the outcome of special events in casino.

Art Unit: 3709

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kang Hu whose telephone number is (571)270-1344. The examiner can normally be reached on 7:30 - 5(M-F) (Off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on 571-272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KH/  
Kang Hu  
Nov 8, 2006

  
**KIM NGUYEN**  
**PRIMARY EXAMINER**